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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/606,369	06/28/2000	John R. Stuelpnagel	A-67493-3/DJB/RMS/DCF	6020

7590 03/15/2002

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EXAMINER

BEISNER, WILLIAM H

ART UNIT	PAPER NUMBER
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1744

10

DATE MAILED: 03/15/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

09/606,369

Applicant(s)

STUELPNAGEL ET AL.

Examiner

William H. B isner

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-18 and 29-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13-18 and 29-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4. 6) ☐ Other:

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DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Group III, claims 13-18, in Paper No. 9 is acknowledged.

Priority

2. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 119(e) and 120 as follows:

An application in which the benefits of an earlier application are desired must contain a specific reference to the prior application(s) in the first sentence of the specification or in an application data sheet (37 CFR 1.78(a)(2) and (a)(5)).

The reference made to related applications is not clear. First, when claiming benefit under 119(e) the language "this is a continuation" should not be used. The language should state that benefit under 119(e) is being claimed to provisional application ###, filed ###/###/##. Also it appears that the instant application is a CIP rather than a continuation of the previously recited US nonprovisional and PCT applications. Clarification and/or correction is requested.

Information Disclosure Statement

3. The information disclosure statement filed 21 Feb. 2001 has been considered and made of record.

Drawings

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4. This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

5. The drawings are objected to because Figure 2 has not be identified as Fig. 2A and Fig. 2B. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 15-18 and 30-34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 15 and 32, while the device includes “at least one alignment means” is it not clear how this “at least one alignment means” structurally cooperates with the rest of the previously recited structures of the device.

In claim 17, it is not clear if the microtiter plate is being positively recited as part of the claimed device or that the base is merely capable of holding a microtiter plate. Claim 13 recites “a base cavity for holding a first array”.

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In claims 18 and 34, while the device includes “at least one fluid handling device” is it not clear how this “at least one handling device” structurally cooperates with the rest of the previously recited structures of the device.

In claim 30, “said first array” lacks antecedent basis.

In claim 31, “said second array” lacks antecedent basis.

Note claims 30 and 31 do not depend from any claims but will be examined as though they depend from claim 29.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 13, 14, 17, 29, 30 and 31 are rejected under 35 U.S.C. 102(b) as being anticipated by Kolehmainen et al.(US 4,349,510).

The reference of Kolehmainen et al. discloses a device which is capable of being used for hybridization which includes a base plate (27); a first array component (microtiter plate, 5); a lid (43) with ports for immobilizing a second array of fiber optic bundles (36); and a sealant (38) between the base plate and the lid.

Claim Rejections - 35 USC § 103

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10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

12. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

13. Claims 15, 16, 32 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kolehmainen et al.(US 4,349,510) in view of Hafeman et al.(US 6,074,614).

The reference of Kolehmainen et al. has been discussed above.

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The above claims differ by reciting the use of alignment structures between the base and lid.

The reference of Hafeman et al. discloses that it is known in the art to provide male/female alignment structures on a base and lid so as to ensure proper alignment between the lid supporting contacting elements for the wells of the base member (See elements 150, 105, 8 and 10).

In view of this teaching, it would have been obvious to one of ordinary skill in the art to provide the lid and base of the primary reference with alignment structures for the known and expected result of providing a means recognized in the art to ensure a proper alignment between the lid holding the fiber optic bundles and the sample wells.

14. Claims 18 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kolehmainen et al.(US 4,349,510) in view of Kearns et al.(US 5,087,820).

The reference of Kolehmainen et al. has been discussed above.

The above claims differ by reciting that the device includes a fluid handling means.

The reference of Kearns et al. discloses that it is known in the art to provide align a microtiter plate array with an array of detectors for each well wherein the structure includes a manifold (25) for contacting the well contents with a fluid.

In view of this teaching, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the structure of the primary reference to include a fluid contacting manifold as suggested by Kearns et al. for the known and expected result of

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providing a means recognized in the art for contacting a reaction fluid with the contents of the wells to be analyzed by the array of detectors supported in the cover of the well plate.


Conclusion

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The references of Hendrix (US 4,407,454); Kubisiak (US 5,144,136); and Beattie (US 5,843,767) are cited as prior art which pertains to arrays of analytical detection devices.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William H. Beisner whose telephone number is 703-308-4006. The examiner can normally be reached on Tues. to Fri. and alt. Mon. from 6:40am to 4:10pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Warden can be reached on 703-308-2920. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.


William H. Beisner
Primary Examiner
Art Unit 1744

WHB
March 8, 2002